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09/30/2004

Fred Bishop

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EXAMINER

COPPOLA, JACOB C

ART UNIT

PAPER NUMBER

3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/711,720 | <b>Applicant(s)</b><br>BISHOP ET AL. |  |
|                              | <b>Examiner</b><br>JACOB C. COPPOLA  | <b>Art Unit</b><br>3621              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04 June 2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Acknowledgements**

1. This action is in reply to the Remarks/Amendments filed on 04 June 2008.
2. Claims 1, 3-6, and 9-11 are currently pending and have been examined.
3. All references to the capitalized versions of "Applicants" refer specifically to the Applicants of record. Any references to lower case versions of "applicant" or "applicants" refer to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. This Office Action is given Paper No. 20080711. This Paper No. is for reference purposes only

### **Information Disclosure Statement**

5. Acknowledgement is hereby made of receipt of the Information Disclosure Statements filed by Applicants on 04 June 2008.
6. Numerous items on the IDS documents filed by the Applicants do not conform to the requirements of CFR §1.98 Content of Information Disclosure Statement, such as "Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication". Accordingly, the items that do not conform to this rule have been considered by the Examiner but not entered into the prior art of record.

**Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph**

7. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 3-6, and 9-11 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

9. **As per claims 1 and 9**, in lines 17-19 of claim 1 (and in relatively the same position in claim 9), the language is directed to positively selecting *both* a first and second data set based on their respective "secondary identifiers". However, in lines 15 and 16 the claim previously recites "facilitating selection of *at least one of* said first data set and said second data set". This claim is therefore indefinite because one of ordinary skill in this art could not understand the scope of lines 17-19 if only the first data set is selected *or* if only the second data set is selected. In other words, the *alternative language* of lines 15 and 16 add confusion to the claim and render the claim indefinite, especially when in the next step, lines 17-19, the *alternative language* is replaced by *positive language*.

10. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

### Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 3-6, 9, and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Pitroda (U.S. 5,590,038 A) ("Pitroda").

13. **As per claim 1**, Pitroda discloses *a method for facilitating the management of a plurality of data sets on a transaction device* (see at least abstract). Additionally, Pitroda discloses the limitations:

- a. *enrolling a first data set owner ("AMERICAN EXPRESS") in multiple transaction accounts ("Credit Cards", "Bank Cards", "ID Cards") and a second data set owner ("VISA") in multiple transaction accounts ("Credit Cards", "Bank Cards", "ID Cards") in association with a transaction device program ("an electronic transaction system which utilizes UET cards")* (see figures 4, 13, and associated text);
- b. *adding to a database ("a universal electronic transaction card ("UET card") which is capable of storing... credit card company account numbers") on the transaction device ("UET card"), a first data set of a first format ("information... regarding the user's American Express account"), wherein said first data set is*

*owned by said first data set owner (see column 2, lines 44+ and column 16, lines 20+);*

c. *adding to a database on the transaction device, a second data set of a second format (similar to information regarding the American Express account, the UET card stores information regarding the Visa account) (see abstract, figure 13, and associated text),*

d. *wherein said second data set is owned by said second data set owner (see figure 13 and associated text),*

*wherein said first owner is distinct from said second owner (Visa is distinct from American Express) (see figure 13 and associated text); and*

e. *said first format is different from said second format (the format of the American Express account information is different from the format of the Visa account information. For example, see abstract, figure 14, and associated text; at least the graphical images of each card stored on the UET card is of a different format);*

f. *wherein said first data set is stored in accordance with said first format, and said second data set is stored in accordance with said second format (see abstract, figures 13, 14, and associated text);*

g. *facilitating selection of at least one of said first data set and said second data set to complete a transaction request ("the user can then select one of a number of credit cards") (see column 16, lines 21+);*

- h. *using a first secondary identifier indicia (security code for American Express card) to select said first data set, and a second secondary identifier indicia (security code for Visa Card) to select said second data set (see figure 13 and associated text; specifically column 16, lines 21+ where Pitroda discloses a security code that may be implemented for the use of each credit card on the UET card); and*
- i. *completing said transaction request according to said selection (see column 16, line 50 through column 17, lines 6).*

Pitroda gives an example of a user selecting a credit transaction in which the credit transaction is processed using an American Express Card (see column 16, lines 21+). Pitroda does not specifically equate the example to all of the credit cards available to the user through the UET card; however it would be obvious to one of ordinary skill in the art that this example applies to all of the credit cards on the UET card.

14. **As per claim 3**, Pitroda discloses the limitations of claim 1, as described above.

Pitroda, further, discloses the limitations:

- j. *verifying at least one of said first secondary identifier indicia and said second secondary identifier indicia (see column 16, lines 21+).*

15. **As per claim 4**, Pitroda discloses the limitations of claim 1, as described above.

Pitroda, further, discloses the limitations:

- k. *authorizing said transaction request relative to at least one of said first data set and said second data set (see column 16, lines 21+).*

16. **As per claims 5 and 6**, Pitroda discloses the limitations of claim 1, as described above. Pitroda, further, discloses the following limitations:

- l. *wherein the step of facilitating selection further comprises facilitating allocation of a first portion of said transaction request to said first data set for transaction completion (see at least column 16, lines 21+); and*
- m. *wherein the step of facilitating selection further comprises facilitating allocation of a second portion of said transaction request to said second data set for transaction completion (see at least column 16, lines 21+).*

In the rejection to claims 5 and 6, as shown above, the Examiner has made a factual determination based on the inherent characteristics of a transaction request. Inherently, a transaction request comprises numerous “portions”. For example, let  $Y =$  the transaction request, and suppose the transaction request is for a payment of \$50. Then  $Y = 50$ , and applying the inherent mathematical law of the zero property of addition (also referred to as the identity property of addition),  $Y = 50 + 0$ . Therefore, a transaction request that can be defined as a number inherently comprises at least a first portion and a second portion. Pitroda teaches allocating a transaction amount of a transaction request in at least column 16, lines 21+. Also, Pitroda teaches numerous transaction cards residing on an RFID card, called a UET card. Therefore, by default, and as shown in the example above, Pitroda is teaching allocating of a first portion of said transaction request to said first data set (for example \$50 to the American Express Card) and allocating of a second portion of said transaction request to said second data set (\$0 to any of the other cards).



17. **As per claim 9**, this claim is a medium claim that is not patentably distinct from the method claim of claim 1, as understood by the Examiner. Accordingly, claim 9 is rejected in substantially the same manner as claim 1, as shown above.

18. **As per claim 10**, Pitroda discloses the limitations of claim 9, as described above.

Pitroda, further, discloses the limitations:

n. *wherein the facilitating selection step further comprises facilitating allocation of the entire transaction request to either said first data set or said second data set (see at least column 16, lines 21+).*

19. Claims 5 and 6, if not inherently taught by Pitroda's invention, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Pitroda (U.S. 5,590,038 A) ("Pitroda").

20. **As per claims 5 and 6**, Pitroda discloses the limitations of claim 1, as described above. As shown above and as understood by the Examiner, Pitroda teaches all of the limitations of claims 5 and 6. However, Pitroda *may not specifically teach* the following limitations:

o. *wherein the step of facilitating selection further comprises facilitating allocation of a first portion of said transaction request to said first data set for transaction completion; and*

p. *wherein the step of facilitating selection further comprises facilitating allocation of a second portion of said transaction request to said second data set for transaction completion.*

However, Pitroda in at least column 1, lines 8+ discloses “the present invention is capable of functioning as a number of different credit cards or other transaction or identification cards”. Pitroda also discloses numerous examples of transactions that could utilize his RF card system, such as financial transactions and health service transactions (see column 1, lines 8+). One of ordinary skill in the art would understand that such transactions often have multiple “portions”. For example, a financial transaction may have a “payment portion” and a required “identification portion”. Clearly, Pitroda’s system is capable of applying the payment portion to a first data set on the RF device (i.e. credit card as depicted in figures 13 and 14) and the identification portion of the transaction to a second data set on the RF device (i.e. identification card as depicted in figure 21). The same suggestion could be applied to a health service transaction, where the user is required to submit a “co-pay”. A first “portion” of the health service transaction may require that the user present their health card on from the UET card and a second “portion” of the health service transaction may require that the user present a credit card to facilitate payment of the “co-pay”.

21. Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Pitroda (U.S. 5,590,038 A) (“Pitroda”).

22. **As per claim 11**, Pitroda teaches the limitations of claim 1, as described above. Additionally, this claim encompasses substantially the same scope as claims 5 and 6. Accordingly, claim 11 is rejected in substantially the same manner as claims 5 and 6, as shown above in the second rejection of claims 5 and 6.

23. Claims 5 and 6, if not inherently taught by Pitroda's invention and if not suggested as an obvious use of Pitroda's invention, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Pitroda (U.S. 5,590,038 A) ("Pitroda"), in view of Russell et al. (U.S. 2004/0044627 A1) ("Russell").

24. **As per claims 5 and 6**, Pitroda discloses the limitations of claim 1, as described above. As shown above and as understood by the Examiner, Pitroda teaches all of the limitations of claims 5 and 6. However, Pitroda *may not specifically teach or suggest* the following limitations:

q. *wherein the step of facilitating selection further comprises facilitating allocation of a first portion of said transaction request to said first data set for transaction completion; and*

r. *wherein the step of facilitating selection further comprises facilitating allocation of a second portion of said transaction request to said second data set for transaction completion.*

However, Russell discloses secure methods for conducting transactions, and in addition, Russell in ¶ 0037 discloses the limitations:

s. *wherein the step of facilitating selection further comprises facilitating allocation of a first portion of said transaction request to said first data set for transaction completion; and*

t. *wherein the step of facilitating selection further comprises facilitating allocation of a second portion of said transaction request to said second data set for transaction completion.*

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the RF device of Pitroda to include the transaction portion allocation functionality of Russell's RF device. One would have been motivated to do so because the portion allocation of the transaction provides the user with a higher degree of flexibility when choosing how to pay for commercial products.

25. Claim 11, if not suggested as an obvious use of Pitroda's invention, is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Pitroda (U.S. 5,590,038 A) ("Pitroda"), in view of Russell et al. (U.S. 2004/0044627 A1) ("Russell").

26. **As per claim 11**, Pitroda teaches the limitations of claim 1, as described above. Additionally, this claim encompasses substantially the same scope as claims 5 and 6. Accordingly, claim 11 is rejected in substantially the same manner as claims 5 and 6, as shown above in the third rejection to claims 5 and 6.

27. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

28. Using the broadest reasonable interpretation, the following definitions are relied upon by the Examiner when interpreting claim language:

- u. ***enroll* or *enrol* vb. *enrolled*; *enrolling*** “1: to insert, register, or enter in a list, catalog, or roll”. (Webster’s Ninth New Collegiate Dictionary, Merriam-Webster, Inc., Springfield, MA, 1986)

### **Response to Arguments**

29. Applicants' arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

30. Applicants' amendment filed 04 June 2008 necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

31. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the reference The Bank Credit Card Business by the American Bankers Association (hereinafter “ABA”) is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that ABA is a textbook that introduces the reader to the dynamic bank credit card business. The reference is cited in its entirety. Moreover,

because of the reference's general description of the credit card business, because "[w]ell known text books in English are obvious research materials," *In re Howarth*, 654, F.2d 103, 210 USPQ 689, 692 (CCPA 1981), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that ABA is primarily directed towards those of low skill in this art. Because ABA is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must-at the very least-be aware of and understand the knowledge and information contained within ABA.

32. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C Coppola/  
Examiner, Art Unit 3621  
July 10, 2008

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621